

REMARKS

Applicant has carefully studied the Office Action of January 15, 2004 and offers the following remarks to accompany the above amendments.

Initially, the Patent Office indicated that the declaration was defective. Applicant herein encloses a new declaration with the appropriate recitation about the duty to disclose.

Next, the Patent Office objected to claim 1 for the use of the word "to" and suggested that "at" might be more appropriate. Applicant respectfully disagrees. While contextually "at" does make sense, "to" also makes sense. Thus, Applicant respectfully maintains that there is no informality and requests withdrawal of the objection to claim 1 at this time.

§ 112

Claim 26 was rejected under 35 U.S.C. § 112 as being indefinite since the fueling site did not have antecedent basis. Applicant herein amends claim 25 to depend from claim 21 so that the antecedent basis is established. Applicant requests withdrawal of the § 112 rejection at this time.

Applicant also amends claim 27 to provide a missing colon. No new matter is added.

Double Patenting

Applicant continues to acknowledge the provisional double patenting rejection and will provide a terminal disclaimer for one or the other application in the event that one of the applications matures into a patent.

§ 103

Claims 1, 2, 32-34, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Keidel et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element is located in the reference(s). MPEP § 2143.03.

With respect to claim 1, the Patent Office admits that Keidel et al. does not disclose downloading the software upgrade from a corporate computer to a portable computing device, but opines that it would be obvious to do so such that the upgrade would not have to be written on each portable computer. The motivation offered to do so would be to distribute the software

upgrades in a practical matter. However, this assertion on the part of the Patent Office overlooks a portion of Keidel et al. Specifically, Keidel et al. addresses how the portable computer provides upgrades to the fuel dispenser at col. 7, lines 48-61. That passage clearly indicates that the portable computing device never has the software upgrade thereon, but rather downloads the software from the remote computer 38 to the processor 28 within the fuel dispenser. To this extent, the reference already solves the motivation advanced by the Patent Office and would not suggest the intermediate step of downloading the software to the portable computing device. In short, the reference does not teach or suggest the claim element and the Patent Office has not established *prima facie* obviousness.

Claim 2 depends from claim 1 and is patentable at least for the same reasons.

Claim 32 is similar to claim 1, and the Patent Office's analysis thereof is likewise similar. To this extent, the remarks presented above are applicable, and it is clear that the reference does not suggest downloading the software upgrade to the portable computing device.

Claims 33, 34, and 38 depend from claim 32 and are patentable at least for the same reasons.

Claims 5-7, 10, 12, and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over Keidel et al. in view of Meyer et al. and Shirakawa et al. Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

With respect to claims 5-7 and 10, as explained above, Keidel et al. does not teach or suggest downloading the software upgrade to the portable computing device. Nothing in Meyer et al. or Shirakawa et al. cures this deficiency. Since the references individually do not teach or suggest the claimed invention of the underlying independent claim (1), the combination of references cannot teach or suggest the limitation, and the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not satisfied its burden, the claims are allowable over the rejection of record.

With respect to claims 12 and 13, the Patent Office opines that Shirakawa et al. teaches storing a record indicative of said hardware and software configuration and providing that record to the corporate computer, citing col. 11, line 63 through col. 12, line 11. The cited passage indicates that the client computers 300 transmit the configuration of itself to the server computer 100. However, what the Patent Office fails to show is where the polling of the remote location is done via the portable computing device as recited in claim 12. Specifically, since Shirakawa et

al. teaches that the client computers 300 (which are not the portable computing devices) send the configurations directly, there is no reason to provide the intermediate step of downloading the configuration to a portable computing device. Since there is no reason to have the intermediate step, there is no motivation to modify the combination to perform this recited function. Thus, since the references individually or in combination do not teach or suggest the recited claim element, the references do not establish *prima facie* obviousness for claim 12. Claim 13 depends from claim 12 and is allowable at least for the same reasons.

Claim 3 was rejected under 35 U.S.C. § 103 as being unpatentable over Keidel et al. in view of Eastvold et al. Applicant respectfully traverses. The standard for obviousness is set forth above.

Claim 3 depends from claim 1. As explained above, Keidel et al. does not teach or suggest that the software upgrade is downloaded to the portable computing device as an intermediate step. Nothing in Eastvold et al. cures this deficiency. Since the references individually do not teach or suggest the recited claim element, the combination of references does not teach or suggest the claim element, and the Patent Office has not established *prima facie* obviousness for claim 3.

Claims 8 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over Keidel et al. in view of Muller. Applicant respectfully traverses. The standard for obviousness is set forth above.

As explained above, Keidel et al. does not teach downloading the software upgrade to the portable computing device. Nothing in Muller cures this deficiency. To this extent, the references individually do not teach or suggest a claim element. Since the references individually do not teach or suggest a claim element, the references in combination cannot teach or suggest the claim element. Since the references in combination do not teach or suggest a claim element, the Patent Office has not established *prima facie* obviousness for claims 8 and 9.

Claims 4, 11, and 37 were rejected under 35 U.S.C. § 103 as being unpatentable over Keidel et al. in view of Finley et al. Applicant respectfully traverses. The standard for obviousness is set forth above.

As explained above, Keidel et al. does not show the intermediate step of downloading the software to the portable computing device. Finley et al. does not disclose downloading the software to the portable computing device. Finley et al., as explained on pp. 11-12 of the Appeal

Brief, runs diagnostics and setup routines on the portable computing device, and Finley et al. would have to be modified to have a software upgrade thereon. The Patent Office has not yet provided such a motivation to modify Finley et al. To this extent, the references individually do not teach or suggest the claim element. Since the references individually do not teach or suggest the claim element, the references in combination do not teach or suggest the combination, and the Patent Office has not established *prima facie* obviousness for claims 4, 11, and 37.

Claims 14-31, 35, and 36 were rejected under 35 U.S.C. § 103 as being unpatentable over various combinations of the references previously cited. As these claims either depend from claims previously discussed or have elements which are similar to those previously discussed, it is clear that these references individually or in combination do not teach or suggest the use of the portable computing device in the manner claimed. Specifically, claim 17 recites providing software upgrades on a portable computing device. Similarly, claim 27 recites a portable computing device that downloads a software upgrade from a corporate computer. Claim 30 recites transferring a software upgrade from the corporate computer to the portable computing device. As explained above, this sort of use of the portable computing device is not taught or suggested by any of the references individually and thus cannot be taught or suggested by the combination of references.

With respect to claims 19 and 31, wherein the Patent Office took Official Notice that it was well known to record commissioning obligations, Applicant respectfully traverses the Official Notice thereof. Applicant requests substantiating proof that it was well known to record commissioning obligations in the context of software upgrades.

With respect to claims 24 and 25, wherein the Patent Office took Official Notice that it was well known to determine if upgrading resulted from warranty contract and accounting for upgrading if the upgrading fell outside of a warranty obligation, Applicant respectfully traverses the Official Notice thereof. Applicant requests substantiating proof that it was well known to consider such warranty obligations as part of the accounting for software upgrades.

With respect to claim 29, wherein Official Notice of patches is taken, Applicant respectfully traverses the assertion that it would be obvious to check for and install a patch prior to upgrading. The Patent Office is requested to provide substantiating proof for this assertion.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. Specifically, the Patent Office has still failed to show where a portable computing device

is used as an intermediate device to upgrade software to a remote location. The references of record do this directly, obviating the need for the intermediate step. Since this element is not taught or suggested, the claimed invention is non-obvious and allowable. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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